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10/516,500	12/02/2004	Juan Luis Hancke Orozco	Herbal Powers	4925
22925 7590 03/31/2009 PHARMACEUTICAL PATENT ATTORNEYS, LLC 55 MADISON AVENUE 4TH FLOOR MORRISTOWN, NJ 07960-7397				
EXAMINER RAHMANI, NILOOFAR				
ART UNIT		PAPER NUMBER		
1625				
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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: JUAN LUIS HANCKE, AND
REFAEL AGUSTIN BURGOS AGUILERA

Application No. 10/516,500
Technology Center 1625

Mailed: March 30, 2009

Before KRISTA ZELE *Deputy Chief Appeals Administrator*
ZELE, *Deputy Chief Appeals Administrator*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on August 12, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

EXAMINER'S ANSWER, GROUNDS OF REJECTION

A review of the file indicates that the Examiner's Answer filed December 3, 2007, 2007 does not comply with the guidelines provided in MPEP § 1207.02 because it refers, either directly or indirectly, to a prior Office action without fully restating the point relied upon in the answer. If there is a complete and thorough development of the issues in a prior action, the examiner may copy any referenced prior rejection(s) from the prior Office action into the examiner's answer. The examiner is reminded to reevaluate his or her prior position in light of the arguments presented in the brief, and should expressly withdraw any rejections not adhered to in the "Grounds of Rejection Withdrawn" section of the examiner's answer. Therefore, a substitute examiner's answer which fully restates any prior points relied upon in the answer, is required. *See also Manual of Patent Examining Procedure* (MPEP) § 1207.02 (8th ed. Rev. 6, Sept 2007) for details.

In addition, a review of the file finds that the grounds of rejection of the claims as provided in the Examiner's Answer mailed December 3, 2007, under the heading "Grounds of rejection" is not consistent with the grounds of rejection of claims set forth in the last Office action of record. The grounds of rejection of the claims as provided in the Examiner's Answer must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Each Grounds of rejection to be reviewed on appeal must be identified and any new grounds of rejection must be provided under a separate heading "New Grounds of Rejection" in the Examiner's Answer and must include the approval of the TC Director or his/her designee. *See also Manual of Patent Examining*

Procedure (MPEP) § 1207.02 and 1207.03 (8th ed. Rev. 6, Sept 2007) for details.

More specifically, the grounds of rejection contained in the Final Rejection are as follows:

6. The rejection of claims 53-73 under 35 U.S.C. 102(b) over Babish et al., US 2002/0068098 is maintained for the reason of record.
7. The rejection of claims 53-54, 63, and 66-72 under 35 U.S.C. 102(b) over Wheelock et al., US 5,833,994 is maintained for the reason of record.
8. The rejection of claims 53-73 under 35 U.S.C. 102(b) over Babish et al., US 2002/0077350 is maintained for the reason of record.
9. The rejection of claims 53-54, 65-72 under 35 U.S.C. 102(b) over Wheelock et al., US 6,140,063 is maintained for the reason of record.
10. The rejection of claims 53-54, 64-72 under 35 U.S.C. 102(b) over Babish et al., WO 96/17605 is maintained for the reason of record.
11. The rejection of claims 53-54, and 65-72 under 35 U.S.C. 102(b) over Wheelock et al., WO 98/30213 is maintained for the reason of record.
12. The rejection of claims 53-54, and 66 under 35 U.S.C. 102(b) over Nanduri et al., US 6,410,590 is maintained for the reason of record.
13. The rejection of claims 53-54, 64-72 under 35 U.S.C. 102(b) over Nanduri et al., US 6,486,196 is maintained for the reason of record.
14. The rejection of claims 53-54, 65-72 under 35 U.S.C. 102(b) over Nanduri et al., US 2002/0016324 is maintained for the reason of record.

The ground of rejection contained in the Examiner's Answer are:

- (9) Claims 53-73 are rejected under 102(b). This rejection is set forth in a prior Office Action, mailed on 01/19/2007 and 03/16/2006.
- (a) Claims 66-72 are rejected under 35 U.S.C. 102(b) as being anticipated by Panossian et al., *Phytomedicine*, Vol. 9, pages 598-605.
- (b) Claims 53, 65-66, and 72 are rejected under 35 U.S.C. 102(b) as being anticipated by Wheelock et al., US 5,833,994.
- (c) Claims 53, and 64-72 are rejected under 35 U.S.C. 102(b) as being anticipated by Babish et al., WO 96/17605.

(d) Claims 53-63,66, and 73 are rejected under 35 U.S.C. 102(b) as being anticipated by Nanduri et al., US 6,410,590.

(e) Claims 53-73 are rejected under 35 U.S.C. 102(b) as being anticipated by Babish et al., US 2002/0077350.

Clarification of the record is required for all Grounds of rejection to be reviewed on appeal for all claims.

EXAMINER'S ANSWER

NEW GROUND OF REJECTION

On August 29, 2007, an Examiner's Answer was mailed. The Examiner's Answer included a new ground of rejection, where Claims 53-73 were rejected under 35 U.S.C. § 102(b) as being anticipated by Panossian et al. "Phytomedicine, Vol. 9, pages 598-605", Wheelock et al. (US 5,833,994), Babish et al. WO 96/17605, Nanduri et al. (US 6,410,590), Babish et al. (US 2002/0077350) as evidenced by Samaha et al. "Journal of the American heart Association, 2006, Vol. 26, pages 625-630", Vasantha et al. "Journal of biomolecular screening, 2006, Vol. 11, pages 959-967", and web page from NIH definition Syndrome X.

When a new ground of rejection is introduced in the Examiner's Answer, the Examiner is required to obtain approval of the Technology Center Director or his/her designee. Further, any new ground of rejection is required to be prominently identified, e.g., a separate heading with all capitalized letters. See MPEP § 1207.02(A)(6)(d).

To correct this problem, the examiner will need to vacate the Examiner's Answer mailed August 29, 2007, and mail a Supplemental Examiner's Answer with the approval of the Technology Center Director or designee.

Accordingly, it is ORDERED that the application be returned to the Examiner:

1) to vacate the Examiner's Answer mailed August 29, 2007;

2) to generate a new Examiner's Answer

(a) which does not refer directly or indirectly to a prior Office action without fully restating the point relied on in the answer

(b) setting forth the correct grounds of rejection to be reviewed on appeal

(c) to correct other sections of the Answer as may be required, and

(d) to include the approval of the TC Director or his/her designee (as required for any new grounds of rejection); and

3) such further action as may be required.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

KZ/MTV/dal

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